

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

First named inventor: Minas H. Tanielian Docket No. 02-0778

Serial No.10/692,039 Filed: Jan. 22, 2003

Examiner: Bernarr E. Gregory Art Unit: 3662

Title: **VIRTUALITY ATTACHED NODE** Confirm. No. 6430

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant requests review of the final rejection mailed 14 October 2009 in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reasons stated in the attached sheets.

Respectfully submitted,
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Date: Jan. 13, 2010

REMARKS

Claim 1-84 are pending. The final office action dated 14 October 2009 indicates that claims 1-84 are rejected under 35 USC §112, first paragraph, for failing to comply with the enablement requirement.

Page 5 of the final office action indicates that claims 1-84 are rejected under the enablement requirement because "the specification, while being enabling for EM wavelengths usable by solar cells, does not reasonably provide enablement for EM wavelengths outside of the range usable by solar cells." Page 5 of the final office action further alleges that there is no disclosure for "the use of all of all or even a large portion of the EM spectrum in the invention."

The rejection is respectfully traversed. The rejection is based on legal errors in both claim interpretation and the enablement requirement.

Legal error in claim interpretation

Base claims 1, 23 and 45 each recite converting electromagnetic energy received from an electromagnetic beam and generating electrical power, and base claim 69 recites converting an electromagnetic beam into electrical power. Dependent claims 2-3, 24-25, 46-47 and 70-71 recite that a photocell or solar cell is used for the conversion.

The final office action admits that the specification is enabling for a solar cell, yet it still rejects dependent claims 2-3, 24-25, 46-47 and 70-71 as being non-enabling. It appears that the final office action interprets these dependent claims to recite photocells that convert wavelengths outside of the range usable by solar cells. However, the claims recite no such thing. A plain reading of the claim language simply indicates a photocell for converting an electromagnetic beam into electric power.

Moreover, the claim interpretation makes no sense. Solar cells that convert wavelengths outside of their usable range?

Claims 2-3, 24-25, 46-47 and 70-71 are not being given their broadest reasonable interpretation consistent with the specification, as required by MPEP 2111 and the Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). The specification describes solar cells and photo cells that convert an electromagnetic beam into electrical power. The claim interpretation makes no sense. Thus, the '112 rejection of claims 2-3, 24-25, 46-47 and 70-71 is based on a claim interpretation that is neither reasonable nor consistent with the specification.

The '112 rejection of the remaining claims is also based on erroneous claim interpretation. The office action alleges that there is no disclosure for "the use of all of all or even a large portion of the EM spectrum in the invention. That is, the final office action interprets the remaining claims to recite conversion of all of all or even a large portion of the EM spectrum.

The office action erroneously adds language to the remaining claims. The remaining claims do not recite converters that can convert "all of all or even a large portion of the EM spectrum." They only recite conversion of an electromagnetic beam into electrical power. They should be so interpreted.

Legal error in the enablement requirement

MPEP 2164.04 states "In order to make a rejection, the examiner has the initial burden to establish a reasonable basis to question the enablement provided for the claimed invention... The language should focus on those factors, reasons, and evidence that lead the examiner to conclude that the specification fails to teach how to make and use the claimed invention without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims (citations omitted).

The final office action alleges the latter. It isolates and analyses only the conversion to electrical power.

MPEP 2164.08 is entitled "Enablement Commensurate in Scope With the Claims." It states

The focus of the examination inquiry is whether everything within the scope of the claim is enabled. Accordingly, the first analytical step requires that the examiner determine exactly what subject matter is encompassed by the claims. See, e.g., *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003)... The examiner should determine what each claim recites and what the subject matter is when the claim is considered as a whole, not when its parts are analyzed individually... The second inquiry is to determine if one skilled in the art is enabled to make and use the entire scope of the claimed invention without undue experimentation.

How a teaching is set forth, by specific example or broad terminology, is not important.... Claims are not rejected as broader than the enabling disclosure under 35 U.S.C. 112 for noninclusion of limitations dealing with factors which must be presumed to be within the level of ordinary skill in the art; the claims need not recite such factors where one of ordinary skill in the art to whom the specification and claims are directed would consider them obvious.

MPEP 2164.08 and MPEP 2164.08(a) state

To demand that the first to disclose shall limit his claims to what he has found will work or to materials which meet the guidelines specified for "preferred" materials in a process such as the one herein involved would not serve the constitutional purpose of promoting progress in the useful arts.

Thus, the inquiry is not whether the specification enables a converter that can convert wavelengths outside of the range usable by solar cells. The inquiry is whether the specification enables a control system for a remote control vehicle (claims 1-22), a remote control vehicle (claims 23-44), a remote-controlled vehicle operation system (claims 45-68), and a method for operating a remote-controlled vehicle (claims 69-84).

The office action does not consider the claims as a whole. Instead, it isolates and analyzes the conversion. Moreover, pages 4-5 (section 9) of the final office action limit the conversion to wavelengths in the range of 1.06 μ m to 1.07 μ m.

These wavelengths are provided as examples. The application does not limit the claims to those wavelengths. The specification provides broad teachings (it describes the functionality) of the converter. These broad teachings allow a person skilled in the art to choose a converter having a "usable" range of wavelengths.

Thus, the specification provides support for the full scope of each base claim as a whole, including the conversion of an EM beam into electrical energy (page 6, lines 25+ offer examples of photocells). The scope of enablement provided by the specification is commensurate with the scope of protection sought by claims 1-84. Therefore, the '112 rejection of claims 1-84 should be withdrawn.

The examiner acknowledges that he does not follow the MPEP. On 11 June 2009, applicant's attorney Hugh Gortler (the undersigned) called Examiner Bernarr Gregory and asked him to identify the legal basis that he was using for the enablement rejection. The undersigned inquired whether the examiner was relying upon the MPEP and, if so, upon which section.

Examiner Gregory stated that he was not relying upon the MPEP. Instead, he was relying solely upon his own reading of the statute 35 USC §112 (this is affirmed on pages 2-3 of the final office action). Based on his personal reading, he says the specification is non-enabling because it does not disclose structure for converting all wavelengths of an EM beam to electrical energy. Had the MPEP been followed instead, a rejection under the first paragraph of 35 USC 112 would not have been raised.

Improper objection to the specification

The office action also objects to the specification for failing to teach one or ordinary skill in the art how to make and use the claimed invention. The objection is traversed because it is based on legal error (as discussed above).

Conclusion

No rejections have been made under sections 102 or 103. For the reasons above, the '112 rejection should be withdrawn, and claims 1-84 should be allowed.

Respectfully submitted,

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